

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT

Assignee:	International Flora Technologies, Ltd.	Docket No.	FLORA.1300
Serial No.	10/611,775	Inventor:	John C. Hill
Filing Date:	June 30, 2003	Examiner:	Jyothsna A. Venkat
TITLE:	HIGH UNSAPONIFIABLES AND METHODS OF USING THE SAME	Art Unit:	1615

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Commissioner:

In response to the restriction requirement dated 06/14/2007, Applicant enters a provisional election with traverse, as detailed below:

Provisional Election

Applicant respectfully traverses this restriction requirement but enters a provisional election of the patentably indistinct species corresponding to jojoba oil (16).

Traversal

The Examiner proposes that the instant application “contains claims directed to [...] patentably distinct species” where “the organic material [of claim 36, comprises: (1) Amaranth seed oil, (2) Anise seed oil, (3) Avocado seed oil, (4) Barley oil, (5) Briza oil, (6) Buckwheat oil, (7) Candelilla wax, (8) Carnuba wax, (9) Cassia occidentalis oil, (10) Coffee bean oil, (11) De-oiled lecithin, (12) Dog fish oil, (13) Esparto wax, (14) Oils from fungi and other microorganisms, (15) Guayule plant extract, (16) Jojoba oil, (17) Jurinea oil, (18) Lanolin, (19) Laurel berry oil, (20) Olestra (olean), (21) olive oil concentrate (phytosqualene), olive seed oil, (22) Orange roughly oil, (23) Ouricury wax, (24) Quinoa seed oil, (25) Rye germ oil, (26) Shark liver oil, (27) Shea butter, (28) Sperm whale oil, (29) Sugar cane wax, (30) Sunflower wax, (31) Tall oil, tall oil distillate, (32) Vegepure from wheat grains, and (33) wheat germ oil]”. The Examiner further proposes that these generic variants represent “[s]pecies [that] are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species”. Additionally, the Examiner erroneously asserts that “these species are not obvious variants of each other based on the current record”.

Applicant respectfully traverses this requirement for restriction, but hereby enters a provisional election of the patentably indistinct species corresponding to jojoba oil (16).

The Examiner wrongly suggests that “[t]here is an examination and search burden [...] due to [the patentably indistinct species’] mutually exclusive characteristics.” Applicant respectfully submits that the Examiner has mischaracterized the proposed scope of the search corresponding to the subject matter of claim 36. Specifically, claim 35 (from which claim 36 detrimentally depends) is directed to “[a] method of providing substantial benefits to an animal subject with application of a composition to at least one of said animal subject’s hair, skin, scales and feathers; said method comprising the step of adding an effective amount of said composition to an acid gelling agent in order to neutralize the gelling agent; wherein said composition comprises polar hydrophilic salts and non-polar unsaponifiables, wherein said polar hydrophilic salts comprise the products of hydrolysis of a saponifiable fraction of **original organic material that comprises at least more than about 10 weight percent unsaponifiable material prior to**

hydrolysis.” (emphasis added). Accordingly, claim 35 provides the basis for a generic genus corresponding to “polar hydrophilic salts” derived from the “hydrolysis of a saponifiable fraction of original organic material that comprises at least more than about 10 weight percent unsaponifiable material prior to hydrolysis.” Claim 36, which incorporates all the limitations of claim 35, discloses generic variants of the genus corresponding to polar hydrophilic salts derived from “organic material that comprises at least more than about 10 weight percent unsaponifiable material prior to hydrolysis.” In other words, all the generic variants listed in claim 36 may be classified (and therefore searched within a substantially unitary scope) as corresponding to polar hydrophilic salts derived from “organic material [comprising] at least more than about 10 weight percent unsaponifiable material prior to hydrolysis” as required by claim 35. Consequently, the generic variant oils listed in claim 36 may not be properly considered as patently distinct and, furthermore, do not exhibit mutually exclusive characteristics; rather, the generic variant oils of claim 36 all correspond to and demonstrate the qualities of organic materials having at least more than about 10% unsaponifiable material by weight prior to hydrolysis.

The Examiner goes on to suggest that “the [proposed] species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries)”. Applicant respectfully submits that this is not at all the case. By the Examiner’s own admission on page 4 at line 6, claim 35 constitutes a “generic claim”. Claim 35 provides the basis for a coherent grouping of generic variants of organically sourced materials (i.e., natural oils) that appear in claim 36. Accordingly, it would be expected that the scope of a search performed on claim 35 for the genus corresponding to “organic material [comprising] at least more than about 10 weight percent unsaponifiable material prior to hydrolysis” would return substantially similar results as those returned from separate searches performed for each of the representative natural oils appearing in claim 36. In other words, the scope of a search performed under claim 36 would not broaden the scope of any search already performed under claim 35, nor require any further searching specifically directed to individually recited oils of claim 36 to the extent that all of the specifically recited oils of claim 36 are generic variants of “organic material [comprising] at least more than about 10 weight percent unsaponifiable material prior to hydrolysis” with respect to each other.

The Examiner goes on to incorrectly recommend that “the prior art applicable to one species would not likely be applicable to another species.” Applicant respectfully submits that in view of the discussion above, this assertion is not only wrong, but also *non sequitur*. Specifically, claim 36 recites oils which constitute generic variants of the linking genus – the same corresponding to “organic material [comprising] at least more than about 10 weight percent unsaponifiable material prior to hydrolysis”. As explained *vide supra*, the generic variant oils recited in claim 36 would not require a different field of search and would not require additional searching directed to specific individual generic variants. Accordingly, prior art references (if any) that may be relevant to any given generic variant appearing in claim 36 would likely be discovered in the search directed to the subject matter of the linking genus of claim 35 itself.

Finally, the Examiner suggests that “the species are likely to raise different non-prior art issues under 25 U.S.C. §101 and/or 35 U.S.C. §112, first paragraph”. Applicant respectfully submits that this line of reasoning is inapplicable in the instant case. Additionally, the Examiner has failed to enter any support for this specious proposition into the record. Claim 36 discloses generic variants of the genus corresponding to “organic material [comprising] at least more than about 10 weight percent unsaponifiable material prior to hydrolysis”, as required by the limitations of dependence from claim 35. Accordingly, the oils listed in claim 36 may not properly be considered to be patently distinct and do not exhibit mutually exclusive characteristics, and thus are unlikely to raise different non-prior art issues under 25 U.S.C. §101 and/or 35 U.S.C. §112, first paragraph.

Applicant hereby respectfully requests reconsideration of the instant restriction requirement and reserves their right to petition a final requirement for restriction in accordance with 37 C.F.R. §1.144.

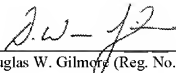
This provisional election is made with traverse, but without prejudice to or disclaimer of the other claims or inventions disclosed. Applicant asserts the right to claim additional species in the event that a generic claim, such as claims 35, 37-38 and 40, is found to be allowable in

accordance with 37 C.F.R. § 1.141(a). Reconsideration and allowance of all pending claims are respectfully requested.

If there are any questions or concerns, please contact the undersigned at the telephone number indicated below.

Respectfully submitted,

Date: July 16, 2007



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